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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Miriam Fields-Babineau	:	
Serial No.: 09/736,408	:	Art Unit: 3644
Filed: December 15, 2000	:	Examiner: Smith, Kimberly 703-308-8515
For: COMFORT TRAINER ("CANINE HEAD HALTER")	:	Atty Docket: 4523-001 (MFB-0001)

PETITION TO THE DIRECTOR UNDER 1.181
REQUESTING WITHDRAWAL OF FINALITY OF OFFICE ACTION

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This is a Petition to the Director under 37 C.F.R. § 1.181 requesting withdrawal of the finality of the outstanding Office Action dated November 20, 2003 as being premature.

The Director is respectfully requested to exercise discretion in accordance with 37 C.F.R. § 1.113(a) in view of the extra-ordinary circumstances that have transpired in this case.

The following remarks are respectfully submitted.

I. BACKGROUND

In a final Office Action dated October 9, 2002, claims 6-25 were rejected. Claim 7 was rejected under **35 U.S.C. § 102(b)** as anticipated by Borchelt et al., U.S. Patent No. 5,992,352.

On August 7, 2003, Applicant filed an Appeal Brief.

In a final Office Action dated November 20, 2003, the examiner re-opened prosecution that was "**Responsive to the communication filed 07 August 2003**" -- the Appeal Brief. Claim 7 now stands rejected under a different statutory basis, namely **35 U.S.C. § 103(a)** as unpatentable over Borchelt et al., U.S. Patent No. 5,992,353 in view of "Snoot Loop Halter for Dogs by Peter Borchelt."

The Office Action also relies for the first time upon DeGroot, U.S. Patent No. 4,483,275, and has apparently withdrawn reliance on Whitman, U.S. Patent No. 207,467. The final Office Action stated "Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action."

By way of an Advisory Action dated February 27, 2004, the Office stated "the current finality was necessitated by the Applicant's previous amendment in which claims 7-25 were added." This was Applicant's non-final Amendment dated August 20, 2002 filed before appeal.

II. RULE

The examiner may re-open prosecution after an appeal is filed. M.P.E.P. § 1208.02 provides:

> The Office action containing a new ground of rejection may be made final if the new ground of rejection was (A) ***necessitated by amendment***, or (B) based on information presented in an information disclosure statement under 37 CFR 1.97(c) where no statement under 37 CFR 1.97(e) was filed. See MPEP § 706.07(a).

The Examiner Note of M.P.E.P. § 1208.02 provides:

> The finality or non-finality of an Office action following a reopening of prosecution depends on whether the action could have been properly made final had it been entered prior to the appeal.

Thus, the question is whether the Office should issue a second ***final*** Office action changing the statutory grounds of rejection, relying upon a new reference, and apparently withdrawing reliance of another reference, where there has been no ***intervening*** amendment. Applicant respectfully submits that such finality is premature especially in view of the extraordinary circumstances set forth below.

III. ANALYSIS

A. THERE WAS NO "AMENDMENT" NECESSITATING FINALITY

The Applicant submits that finality of the outstanding Office Action is premature.

M.P.E.P. § 706.07(a) provides in pertinent part:

> Under present practice, second or any subsequent actions on the merits shall be final, ***except*** where the examiner introduces a ***new ground of rejection*** that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement . . . .
>
> Furthermore, a second or any subsequent action on the merits . . . will not be made final if it includes a rejection . . . of any claim ***not amended*** by applicant or patent owner ***in spite of the fact that other claims may have been amended to require newly cited art***.

The literal language is instructive. Here, a "subsequent" action on the merits (OA of November 20, 2003 is subsequent to the OA of October 9, 2002) introduced a "new ground of rejection" (claim 7 stands rejected under § 103 rather than § 102) that was not necessitated by any amendment.

The Office Action of November 20, 2003 was ***not*** responsive to an "amendment" but rather responsive to an "appeal brief." The Office Action itself on page 1 states that it is "Responsive to

the communication(s) filed on 07 August 2003." This was Applicant's Appeal Brief. Thus, even though the Advisory Action dated February 27, 2004 indicates that the Office Action of November 20, 2003 was responsive to the Amendment of August 20, 2002 (adding claims 7-25), Applicant respectfully traverses.

The Office Action of November 20, 2003 ***does not give any reason*** for apparently withdrawing the § 103 rejection based on Whitman, U.S. Patent No. 207,467 as set forth in the Office Action of October 9, 2002. Applicant ***only*** addressed the substance of Whitman in the Appeal Brief. Thus, because the Office Action of November 20, 2003 does not address this reference, it is respectfully submitted that the examiner ***did in fact*** respond to Applicant's Appeal Brief dated August 7, 2003 as indicated on page 1 of the action.

Applicant submits that this is a very big step that entailed substantial consideration by the examiner. Not only was the statutory grounds for rejecting claim 7 changed from § 102(b) to § 103(a), but the entire reference to Whitman was apparently removed from consideration. Clearly, Applicant's Amendment of August 20, 2002 could not have both necessitated a new ground of rejection of Whitman and ***also*** necessitated the withdrawal of that very same ground of rejection. If the Appeal Brief was not considered, it is respectfully submitted that the Office has acted arbitrarily and capriciously in violation of due process.

Applicant simply requests a non-final opportunity to address this very confusing situation.

B. STATUS OF EXHIBITS IS UNCLEAR

The Applicant presented exhibits on appeal. The Applicant wishes these exhibits to be of record in the application. The Office Action of November 20, 2003 does not state whether these exhibits have been considered.

Applicant attempted in good faith to present these exhibits again by way of an IDS in accordance with an examiner interview. The intent was to clarify the record. However, in this case, the status of the IDS is now in limbo and the record is unclear for purposes of appeal.

The Applicant respectfully petitions that a non-final action be granted so that Applicant can submit those exhibits on the record.

C. THE AMENDMENT ITSELF WAS FILED AT REQUEST OF EXAMINER

Herein lies the rub. The Amendment After Final dated February 9, 2004 was filed in response to a request by Examiner Poon given during the examiner's interview. Applicant had requested a meeting with an examiner having signatory authority. Please see attached e-mail indicating a response by Kim Smith on November 29, 2003 that ***her SPE***, i.e. Charles Jordan, would be present at the interview. Kindly also see my e-mail confirmation dated December 9, 2003 ***prior to the interview*** indicating my understanding that ***Mr. Jordan would be present*** at the interview.

The very purpose of the interview was to meet with Mr. Jordan because he was signatory on this voluminous and confusing USPTO correspondence. The intent was to further prosecution and avoid another wasted appeal.

For reasons that are as yet unexplained, Mr. Jordan did not attend the interview, but rather Examiner Poon was in attendance. However, the written record clearly demonstrates that Mr. Poon did not take signatory authority in the present application as expected. Instead, Mr. Jordan continues to sign all correspondence, and apparently seeks to disregard the suggestion by Examiner Poon for an After Final Amendment. On the one hand, Applicant complies with a request of one examiner only to have that very request rejected by another examiner.

It is respectfully petitioned that this application be given a unified voice of authority from the USPTO and that a non-final action issue.

D. THE OFFICE ACTION INTRODUCES A NEW REFERENCE

The Office Action dated November 20, 2003 now relies for the first time upon DeGroot, U.S. Patent No. 4,483,275. The Applicant was able to obtain a Declaration from Ms. Alice DeGroot herself and has attempted to submit same on the record before the Office in accordance with the examiner's interview.

However, the Office Action of February 27, 2004 fails to address the status of the IDS and in particular the Declaration. Moreover, all rejections based on DeGroot are "new grounds of rejection" not necessitated by Applicant's amendment that entitle Applicant to a non-final Action. M.P.E.P. § 706.07(e).

The Applicant respectfully petitions that it is unfair for the Office to re-open prosecution, rely upon a new reference, and then fail to afford applicant an opportunity to present evidence as a matter of right regarding that very reference by issuing a final action.

Applicant respectfully petitions for issuance of a non-final action in accordance with fundamental notions of justice.

E. THE OFFICE ACTION OF NOVEMBER 20, 2003 IS NOT "COMPLETE"

37 C.F.R. § 1.104(b) requires an Office Action to be "complete to all matters" and 37 C.F.R. § 1.104(c)(2) further clarifies that "[t]he pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified." In this case, the Detailed Action dated November 20, 2003 states:

> 1. The ***finality*** of the rejection of the last Office action, paper number 14 of October 9, 2002 has been withdrawn. As such, the following action applies.

However, the "finality" and the "rejection itself" are two different things. This is neither trivial nor obvious. M.P.E.P. § 706.07(e), ¶¶ 2, 4 are instructive:

> . . . Occasionally, the ***finality*** of a rejection may be withdrawn in order to apply a new ground of rejection.
>
> . . . Normally, [to withdraw a final rejection for the purpose of entering a new ground of rejection,] the ***previous rejection*** should be withdrawn with respect to the claim or claims involved. (emphasis added).

Clearly, M.P.E.P. § 706.07(e), ¶¶ 2, 4 presume that a previous "rejection" as distinguished from its "finality" is maintained if not withdrawn. The Office Action dated November 20, 2003 simply fails to indicate whether or not the prior rejections have been withdrawn or whether the prior references are continued to be applied to the claims in accordance with 37 C.F.R. § 1.104(c)(2).

The Applicant therefore respectfully submits that the final Office Action dated November 20, 2003 is not "complete" within the meaning of the Rules of Practice in Patent Cases, and as such, should be withdrawn and a new non-final Office Action issued.

CONCLUSION

The totality of the circumstances, including changing the statutory basis for rejection of claim 7 without an intervening amendment, withdrawing the reference to Whitman without an intervening amendment, newly rejecting the claims based on the reference to DeGroot without an intervening amendment, failing to consider the Declaration by Alice DeGroot herself, scheduling a

meeting by SPE Charles Jordan and then failing to attend that meeting, and failing to provide a complete Office Action as required by the Rules of Practice in Patent Cases, all weigh in favor of exercising of discretion by the Office to issue a non-final Office Action.

For the foregoing reasons, Applicant respectfully petitions withdrawal of the finality of the outstanding Office Action.

Respectfully submitted,

Date: 4/12/2004

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Baltimore, MD 21212
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TEM/sef

Todd E. Marlette
Registration No. 35,269

EX. 1

Todd E. Marlette, Esq.

From: "Todd E. Marlette, Esq." <marlette@marletteip.com>
To: <Kimberly.Smith3@USPTO.GOV>
Cc: <charles.jordan@uspto.gov>
Sent: Tuesday, December 09, 2003 11:26 AM
Subject: Re: Interview, Application 09/736408

Dear Ms. Smith:

Greetings,

I look forward to seeing you and Mr. Jordan today at 2:00pm. My cell is 703-231-6600.

Sincerely,

Todd E. Marlette

----- Original Message -----
From: <Kimberly.Smith3@USPTO.GOV>
To: <marlette@marletteip.com>
Sent: Monday, December 01, 2003 1:42 PM
Subject: RE: Interview, Application 09/736408

> Good afternoon,
>
> For clarification, will that be Tuesday the 2nd or Tuesday the 9th?
>
> Thanks,
> Kimberly Smith
>
> -----Original Message-----
> From: marlette@marletteip.com [mailto:marlette@marletteip.com]
> Sent: Saturday, November 29, 2003 7:23 PM
> To: Smith, Kimberly (AU3644)
> Subject: Re: Interview, Application 09/736408
>
>
> Ms. Smith:
>
> Greetings. Let's say 2:00pm on next Tuesday.
>
> Thank you,
>
> Sincerely,
>
> Todd E. Marlette, Esq.

> Registered Patent Attorney
> 380 Homeland Southway, Suite 1A
> Baltimore, MD 21212
>
> 703-231-6600 voice
> 410-821-6544 fax
> marlette@marletteip.com
> www.marletteip.com
>
> ---
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>
> ----- Original Message -----
> From: <Kimberly.Smith3@USPTO.GOV>
> To: <marlette@marletteip.com>
> Sent: Saturday, November 29, 2003 2:57 PM
> Subject: Interview, Application 09/736408
>
>
> > Mr. Marlette,
> >
> > Regarding the interview for application 09/736408, Tuesday afternoon
would
> > fit best into the schedule of my SPE and myself. We should be available
> any
> > time after 1pm. Please let me know what time would be best for you on
> > Tuesday.
> >
> > Thanks.
> >
> > Kimberly S. Smith
> > Patent Examiner AU3644
> > 703-308-8515 CPK5 3A18
> > kimberly.smith3@uspto.gov
> >